

Application No. 10/815,863

IN THE DRAWINGS:

Please amend Figure 3 and Figure 6 as illustrated in red on the attached photocopies. In Figure 3 it is proposed to add reference numeral --6--. In Figure 6 it is proposed to add reference numeral --3--.

REMARKS

Claim Rejections

Claims 1-9 are rejected under 35 U.S.C. § 112, first paragraph. Claims 1, 2, 5-7, 9, 11 and 12 are rejected under 35 U.S.C. § 102(e) as being anticipated by Landers Jr., et al. (U.S. 6,615,520). Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Landers Jr., et al. in view of Wang (U.S. 6,299,372). Claims 4 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Landers Jr., et al. in view of Fung (U.S. 6,236,792). Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Landers Jr., et al. as applied to claim 1 and further in view of Fung.

Drawings

Applicant proposes to amend Figures 3 and 6, as illustrated in red on the attached photocopies. In Figure 3 it is proposed to add reference numeral --6--. In Figure 6 it is proposed to add reference numeral --3--. No "new matter" has been added to the original disclosure by the proposed amendments to these figures. It is believed the foregoing proposed amendments obviate the outstanding objections to the drawings. Approval of the proposed drawing changes is respectfully requested.

New Claims

By this Amendment, Applicant has canceled claims 1-12 and has added new claims 13-26 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a light guide comprising: a light guide element (1) having a plurality of optical fibers (2) located in the light guide element between two opposing ends thereof and forming at least one light passage (3) located along a length of the light guide element; and a lighting device (5) providing a light directed toward one of the two opposing ends of the light guiding element.

Other embodiments of the present invention include: a message located on the light guide element; the light guide element includes a masking and a message (4) located thereon; a message located on a smooth surface of the light guide element; a message located on a smooth surface of the light guide element, the message being applied utilizing heat from an iron; the light guide element has a shape selected from a group consisting of a rectangular plate, a round bar, and a triangular bar; the plurality of optical fibers are molded within the light guide element; and the light guide element is made of a transparent material.

It is submitted that the claimed subject matter is described in Applicant's specification in sufficient detail to enable one having ordinary skill in the art to make and use Applicant's invention without undue experimentation. It is believed that Applicant's specification discloses how to make and use the claimed invention.

The primary reference to Landers, Jr. et al. teaches a light article having a display (305) having a message (320) and at least one orifice (335) located on a flange portion (33), and a light source (345) located in the at least one orifice.

Landers, Jr. et al. do not teach a light guide element having a plurality of optical fibers located in the light guide element between two opposing ends thereof and forming at least one light passage located along a length of the light guide element; nor do Landers, Jr. et al. teach the light guide element has a shape selected from a group consisting of a rectangular plate, a round bar, and a triangular bar.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Landers, Jr. et al. do not disclose each and every feature of Applicant's new claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Landers, Jr. et al. cannot be said to anticipate any of Applicant's new claims under 35 U.S.C. § 102.

The first secondary reference to Wang teaches an advertise effect photo pen having a hollow connecting tube (2) with a transparent surface (21) and a shielding surface (22).

Wang does not teach a light guide element having a plurality of optical fibers located in the light guide element between two opposing ends thereof and forming at least one light passage located along a length of the light guide element; nor does Wang teach the light guide element has a shape selected from a group consisting of a rectangular plate, a round bar, and a triangular bar.

The second secondary reference to Fung teaches a bundle of fibers (1, 20-23) positioned parallel and having a roughened portion (25) forming a message to emit a light there through.

Fung does not teach a light guide element having a plurality of optical fibers located in the light guide element between two opposing ends thereof and forming at least one light passage located along a length of the light guide element; nor does Fung teach the light guide element has a shape selected from a group consisting of a rectangular plate, a round bar, and a triangular bar.

Even if the teachings of Landers, Jr. et al., Wang, and Fung were combined, as suggested by the Examiner, the resultant combination does not suggest: a light guide element having a plurality of optical fibers located in the light guide element between two opposing ends thereof and forming at least one light passage located along a length of the light guide element; nor does the combination suggest the light guide element has a shape selected from a group consisting of a rectangular plate, a round bar, and a triangular bar.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first

made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Landers, Jr. et al., Wang, or Fung that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or

suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Landers, Jr. et al., Wang, nor Fung disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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ANNOTATED MARKED-UP DRAWING

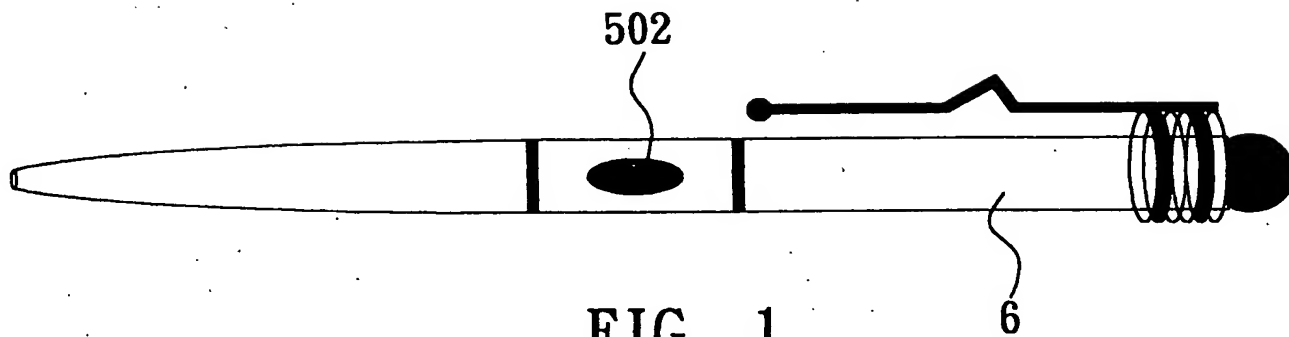


FIG. 1

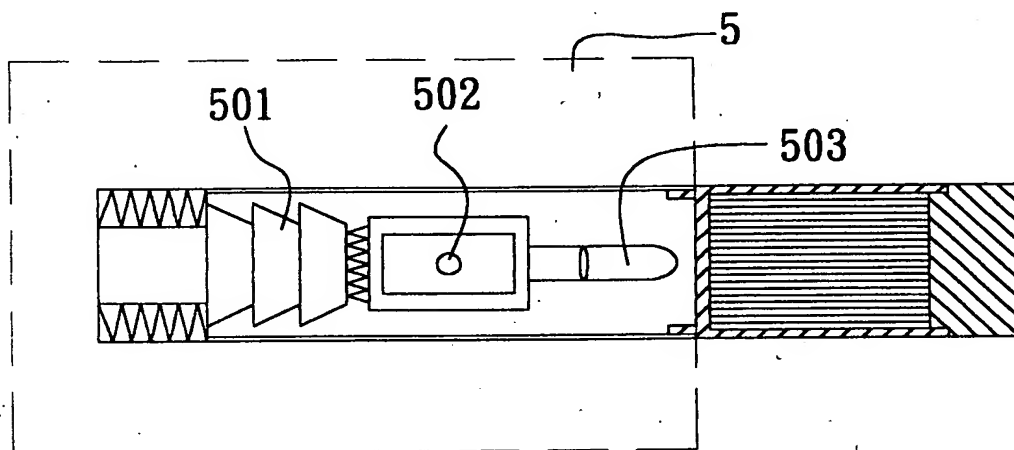


FIG. 2

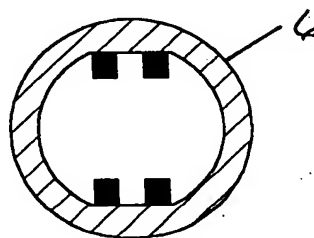


FIG. 3

ANNOTATED MARKED-UP DRAWING

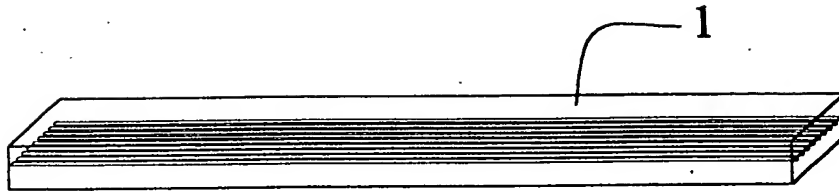


FIG. 4

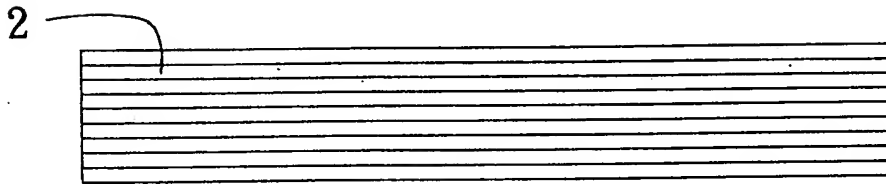


FIG. 5

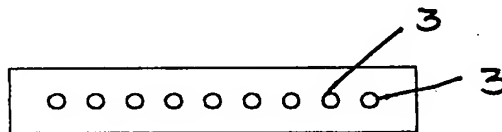


FIG. 6